

REMARKS

In the final Office Action, the Examiner withdrew claims 18-26 and 52-60 from further consideration; rejected claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. (U.S. Patent No. 5,579,379) in view of Riggins (U.S. Patent No. 6,766,454); rejected claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins and Faccinn et al. (U.S. Patent Application Publication No. 2002/0127995); rejected claims 15-17 and 64 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins and Innes (U.S. Patent No. 6,687,743) or Hesselink et al. (U.S. Patent No. 6,499,054) or Eastman (U.S. Patent No. 6,907,032); rejected claims 30 and 33 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Riggins, Faccinn et al., and Fletcher et al. (U.S. Statutory Invention Registration No. H1,897); rejected claims 38-42 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Innes or Hesselink et al. or Eastman and Faccinn et al.; rejected claims 66-68 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Innes; rejected claims 43, 44, 47-51, and 79 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Jordan (U.S. Patent Application Publication No. 2001/0050984) and Hluchyj et al. (U.S. Patent No. 6,282,193); and rejected claims 45 and 46 under 35 U.S.C. § 103(a) as unpatentable over D'Amico et al. in view of Jordan, Hluchyj et al., and Faccinn et al.

By this Amendment, Applicants propose amending claims 1-3, 6, 7, 11, 12, 15, 16, 27-33, 36-43, 61-64, and 66 to improve form. Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 103. Claims 1-64, 66-68, and 75-80 remain pending, of which claims 18-26 and 52-60 have been withdrawn from consideration by the Examiner.

REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL. AND RIGGINS

In paragraph 3 of the Office Action, the Examiner rejected claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins. Applicants respectfully traverse the rejection.

Amended independent claim 1, for example, is directed to a method for placing a call between a first client and a second client. The method comprises receiving a SIP call request message; challenging a device that originated the SIP call request message to authenticate itself, the device performing a first authentication process based on a username and a password associated with the device to generate a first authentication result as a result of authenticating itself; authenticating the SIP call request message by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result to the first authentication result; identifying an authentic originating client when the second authentication result matches the first authentication result; searching a database to determine whether the database includes a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; authorizing the call to be completed if the client billing tag is included in the database; and not authorizing the call to be completed if the client billing tag is not included in the database.

Neither D'Amico et al. nor Riggins, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 1. For example, D'Amico et al. and Riggins do not disclose or suggest receiving a SIP call request message. In fact, D'Amico et al. and Riggins have nothing to do with SIP. Instead, D'Amico et al. relates to

cellular and POTS telephone calls (Fig. 1) and, therefore, could not possibly disclose receiving a SIP call request message as recited in claim 1. Riggins has completely nothing to do with calls at all and, therefore, could not possibly disclose receiving a SIP call request message as recited in claim 1.

D'Amico et al. and Riggins also do not disclose or suggest searching a database to determine whether the database includes a client billing tag that identifies the authentic originating client as a party responsible for paying for the call, as further recited in claim 1.

The Examiner alleged that D'Amico et al. discloses searching a database to find a predetermined client billing tag and cited column 27, line 57 - column 29, line 45, of D'Amico et al. for support (final Office Action, page 7). Irrespective of the Examiner's allegation, Applicants submit that D'Amico et al. does not disclose or suggest searching a database to determine whether the database includes a client billing tag that identifies the authentic originating client as a party responsible for paying for the call, as required by claim 1.

D'Amico et al. is directed to the problem of undesirable calls to cellular phone subscribers who are outside the range of their home base station and, therefore, subject to pay for all incoming calls (col. 8, lines 44-52). D'Amico et al. discloses a caller pays feature, whereby a calling party is prompted to indicate whether they wish to pay cellular air time charges necessary to complete a call to the cellular phone subscriber (col. 8, lines 53-67).

At column 27, line 57 - column 29, line 45, D'Amico et al. discloses that it is determined whether automatic number identification (ANI) can be determined for a received call (col. 27, lines 57-61). If the ANI can be determined, it is determined whether the ANI corresponds to an entry in a VIP table (col. 28, lines 1-7). If the ANI corresponds to an entry in the VIP table, then

the call is established and the called party is charged for the cellular air time charges (col. 28, lines 1-7). If the ANI does not correspond to an entry in the VIP table, then a message is played for the calling party indicating that, to complete the call, the calling party must pay for the cellular air time charges (col. 28, lines 30-34). Upon refusal to accept the charges, the call is routed to voicemail (col. 28, lines 40-44). Upon agreement to accept the charges, a record is created based on the ANI (col. 28, lines 48-60). If the ANI cannot be determined, a message is played for the calling party requesting a PIN (the called party may provide PINs to calling parties who are not required to pay the cellular air time charges) (col. 28, line 61 - col. 29, line 4). If the calling party provides a proper PIN, the call is established and the called party is charged for the cellular air time charges (col. 29, lines 5-10). As an alternative to the PIN or if the calling party provides an incorrect PIN, a message can be presented to the calling party requesting entry of a credit card number to which to bill the cellular air time charges for the call (col. 29, lines 14-18).

Nowhere in this section, or elsewhere, does D'Amico et al. disclose or remotely suggest searching a database to determine whether the database includes a client billing tag that identifies the authentic originating client (which the Examiner equated to the calling party) as a party responsible for paying for the call, as required by claim 1. Riggins also does not disclose these features.

The Examiner alleged that the numbers stored in the VIP list of D'Amico et al. are equivalent to client billing tags (final Office Action, pages 7-8). The Examiner alleged that D'Amico et al. discloses that if the number of the calling party is not listed in the VIP table, then the calling party is notified as the party responsible for paying for the call (final Office Action, page 8). Regardless of the accuracy of the Examiner's allegations, Applicants submit that the

numbers in the VIP table do not identify the calling party (which the Examiner equated to the authentic originating client) as the party responsible for paying for the call, as required by claim 1. Instead, D'Amico et al. specifically discloses that if the number of the calling party is listed in the VIP table, then the call is put through and the called party will pay for the cellular air time (col. 28, lines 1-7). Therefore, contrary to the Examiner's allegations, the numbers in the VIP table of D'Amico et al. cannot be equated to a client billing tag that "identifies the authentic originating client as a party responsible for paying for the call," as required by claim 1.

The Examiner attempts to overcome these deficiencies in the rejection by citing column 27, lines 58-61, of D'Amico et al. as allegedly disclosing that the identity of the calling party must be known to the system in order for the calling party to be charged for the call (final Office Action, page 7). As explained above, D'Amico et al. discloses a situation where the calling party can be charged for the call to a cellular phone subscriber (see, e.g., col. 28, lines 30-34). Nowhere in connection with this situation, however, does D'Amico et al. disclose or suggest searching a database to determine whether the database includes a client billing tag that identifies the calling party (which the Examiner equated to the authentic originating client) as a party responsible for paying for the call, as would be required by claim 1.

Further, the Examiner relied upon Riggins as disclosing the challenging a device feature and the authenticating a call request message feature of claim 1 (final Office Action, page 8). The Examiner alleged that it would have been obvious to one of ordinary skill to include the teaching of Riggins in D'Amico et al. for the "purpose of securing access to services in a computer network" (final Office Action, page 8). Applicants submit that the Examiner's

motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 1.

It is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art at the time of Applicants' invention would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Riggins and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. is directed to the field of cellular communication (col. 8, lines 14-52). Riggins is directed to the non-analogous field of computer networks (col. 1, lines 25-27). Further, D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with secure access to services in a computer network. Therefore, contrary to the Examiner's allegation, combining the disclosure of challenging and authenticating a device, as allegedly disclosed by Riggins, into the cellular communications system of D'Amico et al. would not transform the D'Amico et al. cellular communications system into one with secure access to services in a computer network. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

Further, the Examiner's motivation statement falls short of establishing why one of ordinary skill in the art at the time of Applicants' invention would have been motivated to incorporate Riggins' alleged disclosure of secure access to services in a computer network into the cellular communications system of D'Amico et al. D'Amico et al. discloses using ANI or a

PIN to identify a calling party. The Examiner provided absolutely no reason why one of ordinary skill in the art at the time of Applicants' invention would have been motivated to not use ANI or a PIN to identify the calling party, but instead to use the authentication applet disclosed by Riggins. Applicants submit that the authentication technique using the authentication applet disclosed by Riggins would, at the very least, require a major change to the cellular communications system of D'Amico et al. and, thus, there would not be a reasonable expectation of successfully combining the features of Riggins and D'Amico et al.

For at least these reasons, Applicants submit that claim 1 is patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination. Claims 4, 5, 9, 10, and 75 depend from claim 1 and are, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination.¹ Claims 4, 5, 9, 10, 18-26, and 75 are also patentable for reasons of their own.

For example, claim 75 recites receiving the username and the first authentication result from the device, determining a password that corresponds to the username, performing a hash function based on the username and password, and determining whether a result of the hash function matches the first authentication result.

Neither D'Amico et al. nor Riggins, whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 75. For example, D'Amico et al. and Riggins do not disclose or suggest performing a hash function based on the username and password. D'Amico et al. discloses nothing remotely similar to this feature.

¹ As Applicants' remarks with respect to the base independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicants' silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicants to the Examiner's assertions as to these claims, and Applicants reserve the right to analyze and dispute such assertions in the future.

Riggins discloses using challenge 965 and a registered hash of the user's password to perform a one-way hash (col. 14, lines 19-22). Riggins does not disclose or suggest performing a hash function based on a username and password, as required by claim 75.

The Examiner alleged that Riggins discloses that the global server 920 may retrieve and use user's information 960 such as the user's password, a hash of the user's password, or the user's public key (final Office Action, page 3). The Examiner alleged that these were just examples of information that might be used by Riggins and that it would have been obvious to one of ordinary skill to hash the username and password because this is a "well-known idea in the communications art that pertains to providing access to systems, information, etc, based on the user of the device (i.e. authenticating a user)" (final Office Action, pages 3-4). Nowhere does Riggins disclose or suggest performing a hash function based on a username and password, as required by claim 75. The Examiner has not established by anything other than an unfounded allegation that it is well known to perform a hash of a username and a password. Therefore, the Examiner has not established a prima facie case of obviousness with regard to claim 75.

For at least these additional reasons, Applicants submit that claim 75 is patentable of D'Amico et al. and Riggins, whether taken alone or in any reasonable combination.

Amended independent claim 61 recites features similar to, but possibly different in scope from, features recited in claim 1. Claim 61 is, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 1. Claim 80 depends from claim 61 and is, therefore, patentable over D'Amico et al. and Riggins, whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 61. Claim 80 also recites

features similar to features recited in claim 75. Claim 80 is, therefore, also patentable over D'Amico et al. and Riggins for at least reasons similar to reasons given with regard to claim 75.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 4, 5, 9, 10, 61, 75, and 80 under 35 U.S.C. § 103(a) based on D'Amico et al. and Riggins.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, AND FACCINN ET AL.*

In paragraph 5 of the final Office Action, the Examiner rejected claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins and Faccinn et al. Applicants respectfully traverse the rejection.

Claims 2, 3, 6-8, and 11-14 depend from claim 1. Without acquiescing in the Examiner's rejection with regard to claims 2, 3, 6-8, and 11-14, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claim 1. Claims 2, 3, 6-8, and 11-14 are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 1.

Amended independent claim 27 is directed to a computer-readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The computer-readable medium comprises instructions for receiving a call request message; instructions for challenging a device that originated the call request message to authenticate itself, the device generating an authentication result as a result of authenticating itself; instructions for authenticating the call request message based on the authentication result

to identify an authentic originating client; instructions for searching a database to identify whether the database includes a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; instructions for not authorizing the call to be completed if the database does not include the client billing tag; instructions for authorizing the call to be completed if the database includes the client billing tag; instructions for inserting the client billing tag into the call request message when the call is authorized to be completed; and instructions for forwarding the call request message with the inserted client billing tag when the call is authorized to be completed.

Neither D'Amico et al., Riggins, nor Faccinn et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 27. For example, neither D'Amico et al., Riggins, nor Faccinn et al. discloses or suggests instructions for searching a database to identify whether the database includes a client billing tag that identifies the authentic originating client as a party responsible for paying for the call. As explained above with regard to claim 1, D'Amico et al. and Riggins do not disclose or suggest this feature. The disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins with regard to this feature.

Applicants submit that the Examiner's motivation to combine the disclosures of D'Amico et al. and Riggins lacks merit for at least reasons similar to reasons given with regard to claim 1.

Moreover, the Examiner relied upon Faccinn et al. as allegedly disclosing inserting a client billing tag into a call request message (final Office Action, page 11). The Examiner alleged that it would have been obvious to one of ordinary skill to include the teachings of Faccinn et al. in D'Amico et al. and Riggins for the purpose of billing IP based telephone calls

(final Office Action, page 11). Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 27.

As stated above, it is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art at the time of Applicants' invention would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Faccinn et al. and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with IP based telephone calls. Therefore, contrary to the Examiner's allegation, combining the disclosure of inserting a client billing tag into a call request message, as allegedly disclosed by Faccinn et al., into the cellular communications system of D'Amico et al. would not facilitate billing of IP based telephone calls in the D'Amico et al. cellular communications system. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

For at least these reasons and the reasons given with regard to claim 1, Applicants submit that claim 27 is patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination. Claim 76 depends from claim 27 and is, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 27. Claim 76 also recites features similar to features recited in claim 75. The disclosure of

Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claim 75. Therefore, claim 76 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 75.

Amended independent claim 28 recites features similar to, but possibly different in scope from, features recited in claim 27. Claim 28 is, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least reasons similar to reasons given with regard to claim 27. Claims 29 and 77 depend from claim 28 and are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 28. Claim 77 also recites features similar to features recited in claim 76. Therefore, claim 77 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 76.

Amended independent claim 31 is directed to a method for placing a call between a first client and a second client. The method comprises receiving a SIP call request message from the first client; challenging a device that originated the SIP call request message to authenticate itself; the device generating an authentication result as a result of authenticating itself; evaluating at least one calling feature in a profile of the second client; determining an authentic originating client based on the at least one calling feature and the authentication result; retrieving a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; and inserting the client billing tag into the SIP call request message.

Neither D'Amico et al., Riggins, nor Faccinn et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 31.

For example, D'Amico et al., Riggins, and Faccinn et al. do not disclose or suggest determining an authentic originating client based on at least one calling feature in a profile of the second client and the authentication result.

The Examiner did not address this feature and, therefore, did not establish a prima facie case of obviousness with regard to claim 31.

D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, also do not disclose or suggest retrieving a client billing tag that identifies the authentic originating client as a party responsible for paying for the call, for at least reasons similar to reasons given with regard to claim 27.

Further, Applicants submit that the Examiner's motivation statements regarding the combination of D'Amico et al., Riggins, and Faccinn et al. lack merit for at least reasons similar to reasons given with regard to claim 27.

For at least these reasons, Applicants submit that claim 31 is patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination. Claims 32, 34-37, and 78 depend from claim 31 and are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al. for at least the reasons given with regard to claim 31. Claim 78 also recites features similar to features recited in claim 76. Therefore, claim 78 is also patentable over D'Amico et al., Riggins, and Faccinn et al. for at least reasons similar to reasons given with regard to claim 76.

Claims 62 and 63 depend from claim 61. Without acquiescing in the Examiner's rejection with regard to claims 62 and 63, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al. and Riggins

identified above with regard to claim 61. Claims 62 and 63 are, therefore, patentable over D'Amico et al., Riggins, and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 61.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 3, 6-8, 11-14, 27-29, 31, 32, 34-37, 62, 63, and 76-78 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, and Faccinn et al.

***REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, AND INNES, HESSELINK ET AL., OR EASTMAN***

In paragraph 6 of the final Office Action, the Examiner rejected claims 15-17 and 64 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins and Innes, Hesselink et al., or Eastman. Applicants respectfully traverse the rejection.

Claims 15-17 depend from claim 1, and claim 64 depends from claim 61. Without acquiescing in the Examiner's rejection with regard to claims 15-17 and 64, Applicants respectfully submit that the disclosures of Innes, Hesselink et al., and Eastman do not cure the deficiencies in the disclosures of D'Amico et al. and Riggins identified above with regard to claims 1 and 61. Therefore, claims 15-17 and 64 are patentable over D'Amico et al., Riggins, and Innes, Hesselink et al., or Eastman, whether taken alone or in any reasonable combination, for at least the reasons given with regard to claims 1 and 61.

Moreover, the Examiner alleged that Hesselink et al. and Eastman disclose only one of the features recited in claims 15 and 64 and none of the features recited in claims 16 and 17 (final Office Action, page 13). Therefore, the Examiner did not establish a prima facie case of obviousness with regard to claims 15-17 and 64 based on either Hesselink et al. or Eastman.

In the final Office Action, the Examiner admitted that the Examiner did not allege that Hesselink et al. and Eastman disclose these features of claims 15-17 and 64, but alleged that Innes discloses these features (final Office Action, page 4). Thus, the Examiner admitted that the Examiner's rejection is improper. The Examiner alleged that the features of claims 15-17 and 64 are disclosed by the combination of D'Amico et al., Riggins, and Innes OR D'Amico et al., Riggins, and Hesselink et al. OR D'Amico et al., Riggins, and Eastman. The Examiner has only asserted, however, that the combination of D'Amico et al., Riggins, and Innes allegedly discloses the features of claims 15-17 and 64. Therefore, the Examiner's rejections based on the combination of D'Amico et al., Riggins, and Hesselink et al., and based on the combination of D'Amico et al., Riggins, and Eastman are improper.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 15-17 and 64 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, and Innes, Hesselink et al., or Eastman.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., RIGGINS, FACCINN ET AL., AND FLETCHER ET AL.*

In paragraph 7 of the final Office Action, the Examiner rejected claims 30 and 33 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Riggins, Faccinn et al., and Fletcher et al. Applicants respectfully traverse the rejection.

Claim 30 depends on claim 28, and claim 33 depends on claim 31. Without acquiescing in the Examiner's rejection with regard to claims 30 and 33, Applicants respectfully submit that the disclosure of Fletcher et al. does not cure the deficiencies in the disclosures of D'Amico et al., Riggins, and Faccinn et al. identified above with regard to claims 28 and 31. Therefore, claims 30 and 33 are patentable over D'Amico et al., Riggins, Faccinn et al., and Fletcher et al.,

whether taken alone or in any reasonable combination, for at least the reasons given with regard to claims 28 and 31.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 30 and 33 under 35 U.S.C. § 103(a) based on D'Amico et al., Riggins, Faccinn et al., and Fletcher et al.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL.,
INNES, HESSELINK ET AL., OR EASTMAN AND FACCINN ET AL.*

In paragraph 8 of the final Office Action, the Examiner rejected claims 38-42 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Innes, Hesselink et al., or Eastman, and Faccinn et al. Applicants respectfully traverse the rejection.

Amended independent claim 38, for example, is directed to a computer-readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The computer-readable medium comprises instructions for receiving a SIP call request message; instructions for adding a header to the SIP call request message, the header including a server identifier to identify a server from which the SIP call request message was received; and instructions for transmitting the SIP call request message and the header to a network gateway.

The Examiner alleged that Faccinn et al. discloses receiving a SIP call request message (final Office Action, page 16). The Examiner alleged that it would have been obvious to use the SIP protocol with call request messages in the systems of D'Amico et al. and Innes, Hesselink et al., or Eastman because "doing so would have been to allow for joint billing for GPRS services and IP telephony services" (final Office Action, page 16). Applicants submit that the Examiner's allegation lacks merit.

D'Amico et al. and Innes, Hesselink et al., or Eastman do not even mention SIP. The Examiner has not provided any reasonable explanation of how to implement the SIP protocol in the D'Amico et al. system, why simply implementing the SIP protocol in the D'Amico et al. system would permit the alleged benefit of joint billing for GPRS services and IP telephony services, or why one of ordinary skill in the art at the time of Applicants' invention would seek to obtain the alleged benefit of joint billing for GPRS services and IP telephony services in the D'Amico et al. system. Therefore, the Examiner's allegation falls short of establishing a prima facie case of obviousness with regard to claim 38.

Further, D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al. also do not disclose or suggest instructions for adding a header to the SIP call request message, the header including a server identifier to identify a server sending the SIP call request message, as further recited in claim 38. The Examiner alleged that Innes, Hesselink et al., and Eastman all disclose these features. Applicants disagree.

Innes, Hesselink et al., and Eastman do not even mention SIP. Therefore, Innes, Hesselink et al., and Eastman cannot disclose or remotely suggest instructions for adding a header to a SIP call request message, let alone instructions for adding a header to a SIP call request message, where the header includes a server identifier to identify a server sending the SIP call request message, as further recited in claim 38.

For at least these reasons, Applicants submit that claim 38 is patentable of D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination. Claim 39 depends from claim 38 and is, therefore, patentable over D'Amico et al.,

Innes, Hesselink et al., or Eastman, and Faccinn et al. for at least the reasons given with regard to claim 38.

Independent claim 40 is directed to a computer-readable medium having computer executable instructions for performing a method for placing a call between a first client and a second client. The computer-readable medium comprises instructions for receiving a SIP call request message; instructions for checking the SIP call request message for a server identifier in a security header appended to the SIP call request message, the server identifier identifying a server from which the SIP call request message was received; and instructions for completing the call based on existence of the server identifier in the security header.

The Examiner alleged that Faccinn et al. discloses receiving a SIP call request message (final Office Action, page 16). The Examiner alleged that it would have been obvious to use the SIP protocol with call request messages in the systems of D'Amico et al. and Innes, Hesselink et al., or Eastman because "doing so would have been to allow for joint billing for GPRS services and IP telephony services" (final Office Action, page 16). Applicants submit that the Examiner's allegation lacks merit for at least reasons similar to reasons given with regard to claim 38.

D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination, do not disclose or suggest instructions for checking the SIP call request message for a server identifier in a security header appended to the SIP call request message, the server identifier identifying a server from which the SIP call request message was received, as recited in claim 40. The Examiner did not address this feature and, therefore, did not establish a prima facie case of obviousness with regard to claim 40.

When addressing a different claim, the Examiner alleged that Innes discloses that the client equipment will check for the caller id of the server in order to identify it (final Office Action, page 5). As explained above, Innes has nothing to do with SIP. Therefore, Innes cannot disclose or suggest instructions for checking a SIP call request message for a server identifier in a security header appended to the SIP call request message, the server identifier identifying a server from which the SIP call request message was received, as required by claim 40. Instead, Innes simply discloses that a client can detect the caller id of a server (col. 2, lines 65-67). Such a disclosure falls short of rendering obvious instructions for checking the SIP call request message for a server identifier in a security header appended to the SIP call request message, the server identifier identifying a server from which the SIP call request message was received, as required by claim 40.

For at least these reasons, Applicants submit that claim 40 is patentable of D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al., whether taken alone or in any reasonable combination. Claims 41 and 42 depend from claim 40 and are, therefore, patentable over D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al. for at least the reasons given with regard to claim 40.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 38-42 under 35 U.S.C. § 103(a) based on D'Amico et al., Innes, Hesselink et al., or Eastman, and Faccinn et al.

REJECTION UNDER 35 U.S.C. § 103 BASED ON D'AMICO ET AL. AND INNES

In paragraph 9 of the Office Action, the Examiner rejected claims 66-68 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Innes. Applicants respectfully traverse the rejection.

Independent claim 66 is directed to a network gateway system for placing a call between a first client and a second client. The system comprises a communications interface for establishing a call with a circuit switched network; and a processor coupled to the communications interface, the processor being programmed to receive a SIP call request message, check the SIP call request message for existence of a security header appended to the SIP call request message, the security header including a server identifier identifying a server that forwarded the SIP call request message, and complete the call based on the existence of the security header including the server identifier.

D'Amico et al. and Innes, whether taken alone or in any reasonable combination, do not disclose or suggest the combination of features recited in claim 66. D'Amico et al. and Innes do not disclose or suggest a processor to check a SIP call request message for existence of a security header appended to the SIP call request message, the security header including a server identifier identifying a server that forwarded the SIP call request message for at least reasons similar to reasons given with regard to claim 40.

D'Amico et al. and Innes also do not disclose or suggest a processor to complete the call based on the existence of the security header including the server identifier, as further recited in claim 66. The Examiner alleged that Innes discloses that the client is configured to complete the call (return call) if the header is detected and inherently not complete the call if the header is not detected (final Office Action, page 17). Applicants disagree.

Innes does not disclose or remotely suggest completing a call. Instead, Innes specifically discloses that the client initiates a new call when the caller id of a known server is recognized with respect to an incoming call (col. 9, lines 39-44). Therefore Innes does not disclose or suggest a processor to complete the call based on the existence of the security header including the server identifier, as required by claim 66.

The Examiner alleged that it would have been obvious to include the teachings of Innes in D'Amico et al. for the purpose of establishing a server initiated high level protocol communications session between a server and a client on a mobile computing device (final Office Action, page 17). Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness with regard to claim 66.

As stated above, it is well settled patent law that to establish a prima facie case of obviousness based on a combination of elements disclosed in multiple references, a rejection must provide a reasonable explanation of why one of ordinary skill in the art at the time of Applicants' invention would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants respectfully submit that one of ordinary skill would not have been motivated to combine Innes and D'Amico et al. in the manner suggested by the Examiner.

D'Amico et al. discloses a caller pays feature for use in a cellular communication network (col. 8, line 53 - col. 9, line 10). D'Amico et al. has absolutely nothing to do with server initiated high level protocol communications sessions. Therefore, contrary to the Examiner's allegation, combining the disclosure of adding a header to a call request message where the header includes a server identifier and transmitting the call request message to a client equipment, where the

client equipment is configured to complete the call (return call) if the header is detected, as allegedly disclosed by Innes, into the cellular communications system of D'Amico et al. would not cause the D'Amico et al. cellular communications system to establish a server initiated high level protocol communications session between a server and a client on a mobile computing device. Accordingly, Applicants submit that the Examiner's motivation statement falls short of establishing a prima facie case of obviousness.

For at least these reasons, Applicants submit that claim 66 is patentable of D'Amico et al. and Innes, whether taken alone or in any reasonable combination. Claims 67 and 68 depend from claim 66 and are, therefore, patentable over D'Amico et al. and Innes for at least the reasons given with regard to claim 66.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 66-68 under 35 U.S.C. § 103(a) based on D'Amico et al. and Innes.

***REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., JORDAN, AND HLUCHYJ ET AL.***

In paragraph 10 of the final Office Action, the Examiner rejected claims 43, 44, 47-51, and 79 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Jordan and Hluchyj et al. Applicants respectfully traverse the rejection.

Amended independent claim 43 is directed to a system for placing a call between a first client and a second client. The system comprises a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, the device performing a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, process a SIP call request message received from the first client to determine an authentic originating client by performing

a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result with the first authentication result, obtain a client billing tag that identifies the authentic originating client as a party responsible for paying for the call; and a network gateway coupled to the SIP server, the network gateway being configured to provide at least one of the first client or the second client conditional access to a public switched telephone network.

Neither D'Amico et al., Jordan, nor Hluchyj et al., whether taken alone or in any reasonable combination, discloses or suggests the combination of features recited in claim 43. For example, D'Amico et al., Jordan, and Hluchyj et al. do not disclose or suggest a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, the device performing a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, or process a SIP call request message received from the first client to determine an authentic originating client by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result with the first authentication result.

The Examiner alleged that Jordan discloses these features and cited paragraphs 0035-0052 of Jordan for support (final Office Action, page 18). Applicants disagree.

At paragraphs 0035-0052, Jordan discloses that an ISN authenticates call initiation equipment by sending it a validation request that includes a random number (paragraph 0038). The call initiation equipment performs a one-way hashing function on the random number to generate an authentication identification number that it returns along with a customer wireline

identification number (paragraphs 0042 and 0043). The ISN compares the authentication identification number with its own authentication data (paragraph 0047). Nowhere does Jordan disclose or suggest a SIP server configured to challenge a device that originated the call by requesting the device to authenticate itself, the device performing a first authentication process based on a username and password associated with the device to generate a first authentication result as a result of authenticating itself, or process a SIP call request message received from the first client to determine an authentic originating client by performing a second authentication process based on the username and the password associated with the device to generate a second authentication result and comparing the second authentication result with the first authentication result, as required by claim 43.

The Examiner admitted that Jordan does not disclose or suggest these features, but alleged that it would have been obvious to use a username and password when authenticating a telephone since this is a "well-known and obvious feature in the wireless communication art" (final Office Action, page 6). The Examiner's allegation only addresses the use of a username and password. The Examiner's allegation falls short of alleging or establishing that it would have been obvious to one of ordinary skill in the art at the time of Applicants' invention to perform a first authentication process based on a username and password associated with a device to generate a first authentication result, or perform a second authentication process based on the username and the password associated with the device to generate a second authentication result, as required by claim 43.

Further, the Examiner provided no motivation statement for modifying the disclosure of Jordan in the manner suggested by the Examiner. Therefore, the Examiner has not established a prima facie case of obviousness with regard to claim 43.

For at least these reasons, claim 43 is patentable over D'Amico et al., Jordan, and Hluchyj et al., whether taken alone or in any reasonable combination. Claims 44, 47-51, and 79 depend from claim 43 and are, therefore, patentable over D'Amico et al., Jordan, and Hluchyj et al. for at least the reasons given with regard to claim 43.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 43, 44, 47-60, and 79 under 35 U.S.C. § 103(a) based on D'Amico et al., Jordan, and Hluchyj et al.

*REJECTION UNDER 35 U.S.C. § 103 BASED ON
D'AMICO ET AL., JORDAN, HLUCHYJ ET AL., AND FACCINN ET AL.*

In paragraph 11 of the final Office Action, the Examiner rejected claims 45 and 46 under 35 U.S.C. § 103(a) as allegedly unpatentable over D'Amico et al. in view of Jordan, Hluchyj et al., and Faccinn et al. Applicants traverse the rejection.

Claims 45 and 46 depend from claim 43. Without acquiescing in the Examiner's rejection with regard to claims 45 and 46, Applicants respectfully submit that the disclosure of Faccinn et al. does not cure the deficiencies in the disclosures of D'Amico et al., Jordan, and Hluchyj et al. identified above with regard to claim 43. Therefore, claims 45 and 46 are patentable over D'Amico et al., Jordan, Hluchyj et al., and Faccinn et al., whether taken alone or in any reasonable combination, for at least the reasons given with regard to claim 43.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 45 and 46 under 35 U.S.C. § 103(a) based on D'Amico et al., Jordan, Hluchyi et al., and Faccinn et al.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request the Examiner's reconsideration of the application and the timely allowance of pending claims 1-64, 66-68, and 75-80.

As Applicants' remarks with respect to the Examiner's rejections overcome the rejections, Applicants' silence as to certain assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to dispute these assertions/requirements in the future.

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-64, 66-68, and 75-80 in condition for allowance. Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Amendment should allow for immediate action by the Examiner. Further, Applicants submit that the entry of this Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

If the Examiner believes that the application is not now in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned to discuss any outstanding issues.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,
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